

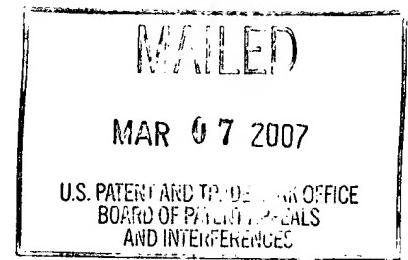
The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PAUL R. SCHIMMEL

Appeal No. 2003-1335
Application No. 08/249,689
Technology Center 1600



ON BRIEF

Before SCHEINER, MILLS, and GRIMES, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of the Board's Decision entered July 20, 2006 affirming the Examiner's rejection of appealed claims 17-19 under the written description requirement of 35 U.S.C. § 112, first paragraph.

BACKGROUND

An opinion was issued in the present appeal (dated October 30, 2003) affirming the final rejection of claims 11-13 and 21 under the first paragraph of 35 U.S.C. § 112 (written description), and reversing the rejection with respect to claims 17-19. In March of 2005, we received a memorandum, originally dated October 3, 2004, from the Directors of Technology Center

1600 requesting rehearing of our decision (TC's Request, page 1), together with Appellant's comments in response (dated November 24, 2004).

The application was remanded to the Examiner for clarification on September 19, 2005. After considering the Examiner's Response to the Remand (dated December 23, 2005), as well as Appellant's subsequent comments (dated January 23, 2006), we granted the TC's Request for Rehearing in a decision dated July 20, 2006, modifying our decision of October 30, 2003, to the extent that the Examiner's rejection of claims 17-19 as lacking adequate written descriptive support was affirmed. As a result, the rejection of all the composition claims in the application under 35 U.S.C. § 112, first paragraph, was sustained.

In response to our modified decision of July 20, 2006, Appellant filed a Request for Rehearing (Appellant's Request, dated September 20, 2006), which we address here.

DISCUSSION

Essentially, Appellant argues that we should have refused to consider TC 1600's request for rehearing in the first place, but having considered it, should have declined to modify our earlier decision.

As to refusing to consider the TC's Request in the first place, Appellant argues that "the [E]xaminer filed a Request for Rehearing on October 14, 2004, almost one year from the October[] 30, 2003 decision" (Appellant's Request 8), which was "[n]ot only . . . untimely, but [] failed to provide notice or opportunity by Appellant to respond" (*id.*).

Moreover, Appellant argues that "[t]he decision was not made based on the claims as they were amended following the [October 30, 2003]

decision by the Board.” *Id.* at 4. Specifically, Appellant argues that “the October 30, 2003[] decision of the Board . . . reversed the rejection with respect to claims 17-19” (*id.* at 7), after which Appellant “amend[ed] rejected claim 11 to incorporate the elements of claim allowable claim 17” and “effectively cancelled the rejected claims” (*id.*).

These arguments do not persuade us that our decision to grant the TC’s Request was in error.

Jurisdiction over an application passes to the examiner after a decision by the Board (37 CFR §§ 1.197(a) and 41.54), as was the case when the application was returned to the Examiner following our decision of October 30, 2003. Any request for relief from an action (or inaction) of an examiner in the *ex parte* prosecution of an application is by way of petition to the Director under the provisions of 37 CFR §§ 1.181-1.183. Appellant had the opportunity to file a petition requesting relief under any of these provisions, but did not do so. Nor has Appellant identified any other avenue for relief that is within our authority or discretion.

Moreover, with respect to notice and opportunity to respond to the TC’s request for rehearing, we note that Appellant did in fact respond (in a submission dated November 12, 2004), and we considered Appellant’s response in conjunction with the TC’s Request.¹ We further note that Appellant responded to the Examiner’s Response to the Board’s Remand, and we considered that response (dated January 23, 2006) as well.

¹ The TC’s Request (originally dated October 3, 2004), together with Appellant’s response (dated November 12, 2004), was forwarded to the Board in March of 2005.

Second, as we explained in our decision of July 20, 2006 (n 3), the TC's Request for Rehearing concerned our decision of October 30, 2003, reversing the final rejection of claims 17-19 as they appeared in the Substitute Appeal Brief of December 9, 2002. The subsequently amended claims were not before us at the time of the October 30, 2003 decision. In any case, as acknowledged by Appellant, independent claim 11 was amended following the October 30, 2003 decision, "incorporat[ing] the language of claim 17," and canceling claim 17. Appellant's Request 7. Review of the claims before and after the amendment (reproduced on pages 5 and 6 of Appellant's Request) reveals no substantive differences between the two sets of claims. Thus, the amendment would have had absolutely no impact on our decision on the merits.

As to the merits of our decision, Appellant argues that the Board "has twice before reviewed this application and very carefully gone through the reams of paper and evidence and heard oral arguments, and then rendered its decisions . . . Then, nearly three years after the second oral hearing, a decision was rendered by a different Board² where the decision does not provide a careful analysis of the facts and legal issues before it, but appears to capitulate to the group's argument that the [A]ppellant's analogy [to antibodies] is incorrect." Appellant's Request 12-13. Nevertheless,

² The merits panel that issued the initial opinion and the remand in this case included Administrative Patent Judge William F. Smith, who retired from the U.S. Patent and Trademark Office before the Examiner submitted his response to the remand. APJ Eric Grimes replaced APJ Smith on the merits panel that issued the opinion of July 20, 2006.

Appellant does not identify any particular points we misapprehended or overlooked in reaching our decision, as required under the provisions of 37 CFR § 41.52(a)(1). Rather, the basis of the request appears to be disagreement with the weight placed on the evidence and the conclusions drawn from that evidence.

Along these lines, citing the intervening decision in *Falkner v. Inglis*, 448 F.3d 1357, 79 USPQ2d 1001 (Fed. Cir. 2006), Appellant argues that the Board “Improperly Relied On the Absence of Working Examples” (Appellant’s Request 15), and “Improperly Relied on the Absence of Actual Reduction to Practice” (*id.* at 16), “factor[s] that the Federal Circuit has expressly ruled [are] not required” (*id.*).

This argument does not persuade us that our decision was in error. It is true that “examples are not necessary to support the adequacy of a written description” and “the written description standard may be met . . . even where actual reduction to practice of an invention is absent” (*Falkner*, 448 F.3d at 1366, 79 USPQ2d at 1007). Indeed, “only enough must be included to convince a person of skill in the art that the inventor possessed the invention” (*id.*, citing *LizardTech, Inc. v. Earth Resource Mapping, PTY, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1732 (Fed. Cir. 2005)). Nevertheless, in the absence of examples or actual reduction to practice, the requirement for an adequate written description must be satisfied in some other way. For the reasons set forth in our decision of July 20, 2006, we concluded that Appellant’s disclosure did not do so.

SUMMARY

Having considered Appellant's request for rehearing to the extent discussed above, we adhere to our decision of July 20, 2006 and decline to modify it in any way.

REHEARING DENIED

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